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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,483	03/12/2004	Yin S. Tang	M-15347 US	8401
32605 7590 06/15/2007 MACPHERSON KWOK CHEN & HEID LLP 2033 GATEWAY PLACE SUITE 400 SAN JOSE, CA 95110			EXAMINER BLEVINS, JERRY M	
			ART UNIT 2883	PAPER NUMBER
			MAIL DATE 06/15/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/799,483

Applicant(s)

TANG, YIN S.

Examiner

Jerry Martin Blevins

Art Unit

2883

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2007.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments filed April 5, 2007 have been fully considered but they are not persuasive.

In response to applicant's allegation that previous Office Actions have included piecemeal examination, examiner contends that applicants misunderstand the definition of piecemeal examination as applied in MPEP 707.07(g). Piecemeal examination refers to examination of specific claims outside of the context of the claimed subject matter as a whole. It does not refer to distinct rejections from multiple Office Actions. As such, examiner has not been guilty of piecemeal examination, since references have been applied to reject as large a number of claims as possible, with secondary references being applied whenever necessary, always with ample motivation to combine the references. Furthermore, while examiner admits that the present application has been rejected multiple times, some times with distinct art with respect to that applied prior Office Actions, no piecemeal examination has occurred, even if applicant's definition were to hold. The bulk of the rejected claims have been rejected using the same art from one office action to the next, whereas any new rejection has generally only been applied to the independent claims, as necessitated by examiner's new understanding of the claimed subject matter due to effective arguments from applicant. Examiner would also like to point out that applicant's original amendment, dated October 20, 2005, contained new claimed subject matter, and the subsequent new grounds of amendment

Art Unit: 2883

was necessitated by said new claimed subject matter. Therefore, examiner has applied new art to reject the claimed invention that does not include any new claimed subject matter only twice. Examiner's willingness to admit persuasive arguments from applicant on limited occasions should not be construed as piecemeal examination.

Regarding applicant's arguments against the applied reference to Okubo et al, US 5,565,978, examiner points out column 8, lines 15-17 and column 10, lines 24-26 which state that end of the optical fiber is modified by etching (i.e. removal of material) to form a lens or rounded-tip tapered shape. Thus, Okubo specifically teaches removal of material to form a lens surface which continuously tapers. This etching process is certainly not the same as polishing as applicant asserts. This etching process is also not performed after the lens or end of the fiber is formed, as applicant asserts, as Okubo specifically states that the etching to a lens surface or rounded-tip tapered shape. Therefore, Okubo does teach removing material to first form a continuously tapered end.

Regarding applicant's arguments against the applied reference to Yamane et al, US 5,459,803, examiner maintains that ample motivation to combine Thompson in view of Yamane has been given. Applicant is in error concerning assertion that the arguments against the combination of Thompson and Yamane were overcome in Applicant's Pre-Appeal Brief Request. Those details that were overcome by said request were specifically addressed in the immediate subsequent Office Action.

Regarding applicant's arguments against the applied reference to Wei et al, US 2004/0134884, examiner points out that specific motivation to combine Wei with the

other applied reference which is found directly within the text of the Wei reference has been given in the prior Office Action. The combination of Wei is not directed to the teaching of Wei concerning HF solution but rather to the teaching of the use of oil on the top of the etching liquid.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 6, 7, 10, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent to Thompson, number 5,037,174 in view of Okubo.

Regarding claim 1, Thompson teaches a method for manufacturing an optical fiber member (Figures 3A,3B,4) comprising: modifying at least one end of an optical fiber member (column 2, lines 14-46) to form an end continuously tapered to the outer circumference of the optical fiber member (Figures 3A,3B,4); and applying energy to the modified end of the fiber (column 2, lines 14-46) to form a lens surface (60), wherein the lens surface continuously tapers outward to the outer circumference of the optical fiber member (Figures 3A,3B,4). Thompson does not teach that the modifying comprises removing material from the at least one end of the optical fiber member. Okubo teaches removing material from an optical fiber to form a lens tip at the end of a continuous

taper (column 8, lines 13-24 and column 10, lines 23-20). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the fiber member of Thompson by removing material, as taught by Okubo. The motivation would have been to more accurately and economically control the modification.

Regarding claims 6 and 11, Thompson teaches that the applying energy to the modified end comprises heating the modified end (exposing the modified end to a heat source) to form the lens surface (column 2, lines 14-46).

Regarding claim 7, Thomson teaches that the lens surface comprises a convex lens surface (Figure 4).

Regarding claim 10, Thompson teaches that the modified end has a first length, and wherein the applying energy comprises applying energy at a location along the length to from the lens surface at a position on the modified end having an angle of between 15 degrees to about 20 degrees (column 5, line 63 – column 6, line 8, wherein the angle is preferably 18 degrees).

Claims 3-5, 13-17, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson in view of Okubo and further in view of US Patent to Yamane et al., number 5,459,803.

Regarding claims 3 and 4, Thomson in view of Okubo teaches the limitations of the base claim 1. Thomson does not teach that the modifying comprises etching the at least one end of the optical fiber member by subjecting the at least one end of the optical fiber member to an etching liquid. Yamane teaches modifying at least one end

of an optical fiber, wherein the modifying comprises etching the at least one end of the optical fiber member by subjecting the at least one end of the optical fiber member to an etching liquid comprising HF acid (abstract and column 4, lines 10-22) It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Thompson with the use of the etching liquid of Yamane. The motivation would have been to improve the efficiency of the modifying.

Regarding claim 5, Thompson in view of Okubo teaches the limitations of the base claim 1. Thompson does not teach that the optical fiber member comprises a material taken from the group consisting of glass, polymer and plastics. Yamane teaches that the optical fiber member comprises glass (column 3, lines 55-64, column 4, lines 1-9, and column 5, lines 55-66). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Thompson with the glass fiber of Yamane. The motivation would have been to improve the durability of the fiber.

Regarding claims 13-16, Thompson in view of Okubo teaches a method for manufacturing an optical fiber (Figures 3A,3B,4) comprising: providing a cylindrical fiber (F); modifying a first end of the fiber (column 2, lines 14-46) to form a tip continuously tapered to the outer circumference of the fiber (Figures 3A,3B,4); and heating the tip (column 2, lines 14-46) to form a lens surface (60) continuously tapers outward to the outer surface of the fiber (Figures 3A,3B,4). Thompson does not teach that the fiber is optically transparent (comprising a material taken from the group of glass, polymer, and plastics) and that the modifying involves etching. Yamane teaches a method for manufacturing a lensed tip optical fiber, wherein the fiber is optically transparent

(column 3, lines 55-64, column 4, lines 1-9, and column 5, lines 55-66 teach a quartz-based glass fiber, which is intrinsically optically transparent); and a modification step includes etching (using a HF acid etching liquid) a first end of the optically transparent cylindrical fiber to form a tip (abstract and column 4, lines 10-22). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the Thompson with the (transparent) glass fiber of Yamane. The motivation would have been to improve the durability of the fiber. It also would have been obvious to one of ordinary skill in the art at the time of the invention to modify Thompson with the etching (HF acid liquid) of Yamane. The motivation would have been to improve the efficiency of the modifying.

Regarding claim 17, Thompson in view of Okubo and further in view of Yamane teaches the limitations of the base claim 13. Thomson also teaches that the lens surface comprises a convex lens surface (Figure 4).

Regarding claim 20, Thompson teaches an optical fiber (Figures 3A,3B,4) comprising: a first lens surface (60) formed on a first end of a cylindrical fiber (F), the first lens surface formed by modifying at least one end of the fiber (column 2, lines 14-46) to form an end continuously tapered to the outer circumference of the fiber (Figures 3A,3B,4); and applying energy to the modified end of the fiber (column 2, lines 14-46) to form the first lens surface (60), wherein the lens surface continuously tapers outward to the outer circumference of the fiber (Figures 3A,3B,4). Thompson does not teach that the modifying comprises removing material from the at least one end of the optical fiber member. Okubo teaches removing material from an optical fiber to form a lens tip at the

Art Unit: 2883

end of a continuous taper (Figures 1-4 and column 2, line 40 – column 4, line 19). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the fiber member of Thompson by removing material, as taught by Okubo. The motivation would have been to more accurately control the modification. Thompson also does not teach that the fiber is optically transparent. Yamane teaches a lensed tip optical fiber, wherein the fiber is optically transparent (column 3, lines 55-64, column 4, lines 1-9, and column 5, lines 55-66 teach a quartz-based glass fiber, which is intrinsically optically transparent). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the Thompson with the (transparent) glass fiber of Yamane. The motivation would have been to improve the durability of the fiber.

Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomson in view of Okubo and further in view of US Pre Grant Publication to Cesaroni, US 2003/0029040.

Regarding claim 8, Thompson in view of Okubo teaches the limitations of the base claim 1. However, Thompson does not teach removing material from both ends of the optical fiber member. Cesaroni teaches a fiber with lenses formed on both ends of the fiber. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Thompson to include lenses on both ends of the fiber, as taught by Cesaroni. This modification would necessitate that the step of removing material be repeated on both ends of the optical fiber member. The motivation would have been to improve collimation and focusing of light entering and exiting the optical fiber member.

Regarding claim 9, Thompson in view of Okubo teaches the limitations of the base claim 6. Thompson also teaches that the heating comprises heating the modified end to form a lens surface (column 2, lines 14-46) on the modified end. Thompson does not teach heating both ends to form a lens surface on each end. Cesaroni teaches a fiber with lenses formed on both ends of the fiber. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Thompson to include lenses on both ends of the fiber, as taught by Cesaroni. This modification would necessitate that the step of heating be repeated on both ends of the optical fiber member. The motivation would have been to improve collimation and focusing of light entering and exiting the optical fiber member.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson in view of Okubo and further in view of US Patent to Grasso, III et al., number 6,375,651.

Regarding claim 12, Thompson in view of Okubo teaches the limitations of the base claim 1. Thompson does not teach moving the modified end to a spark. Grasso teaches a method for manufacturing an optical fiber member comprising: modifying at least one end of an optical fiber member; and applying energy to the modified end of the optical fiber to form a lens surface (column 9, lines 3-23), wherein the applying energy comprises moving the modified end to a spark (column 6, lines 20-34). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify

Thompson with the teaching of Grasso. The motivation would have been to expedite the formation of the lens.

Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson in view of Okubo and further in view of Yamane as applied to claim 13 above, and further in view of Cesaroni.

Regarding claim 18, Thompson in view of Okubo and further in view of Yamane teaches the limitations of the base claim 13. Yamane specifically teaches that the etching comprises etching the first end of the optically transparent cylindrical fiber (abstract and column 4, lines 10-22). Thompson in view of Yamane does not teach that the etching comprises etching both the first end and the second end of the optically transparent cylindrical fiber. Cesaroni teaches a fiber with lenses formed on both ends of the fiber. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Thompson in view of Yamane to include lenses on both sides of the fiber, as taught by Cesaroni. This modification would necessitate that the step of etching, taught by Yamane, be repeated on both ends. The motivation would have been to improve collimation and focusing of light entering and exiting the optical fiber member.

Regarding claim 19, Thompson in view of Okubo and further in view of Yamane and further in view of Cesaroni teaches the limitations of the base claim 18. Thompson specifically teaches that the heating comprises heating the first end to form a lens on the first end (column 2, lines 14-46). Thompson in view of Yamane does not teach that

the heating comprises heating both the first end and the second end to form a lens on each end. Cesaroni teaches a fiber with lenses formed on both ends of the fiber. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Thompson in view of Yamane to include lenses on both sides of the fiber, as taught by Cesaroni. This modification would necessitate that the step of heating, taught by Thompson, be repeated on both ends. The motivation would have been to improve collimation and focusing of light entering and exiting the optical fiber member.

Claims 21 and 22 rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson in view of Okubo and further in view of Yamane as applied to claims 3 and 15 above, and further in view of US Pre Grant Publication to Wei et al., number 2004/0134884.

Regarding claims 21 and 22, Thompson in view of Okubo and further in view of Yamane teaches the limitations of the base claims 3 and 15, respectively. Thompson does not teach that the etching liquid comprises oil on the top surface of the etching liquid. Wei teaches oil placed on the top surface of an etching liquid (page 2, paragraph 19). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Thompson in view of Yamane with the oil of Wei. The motivation would have been to increase protection of the fiber (Wei, page 2, paragraph 19).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry Martin Blevins whose telephone number is 571-272-8581. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frank G. Font can be reached on 571-272-2415. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2883

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JMB



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